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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,943	12/05/2001	Mario Noli	6023-143US (MI/X13874)	7784

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

KIM, PAUL D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 07/22/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary

Application No.

10/005,943

Applicant(s)

NOLI, MARIO

Examiner

Paul D Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is a response to the amendment filed on 6/4/2003.

Election/Restrictions

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A, drawn to Fig. 2.

Species B, drawn to Fig. 3.

Species C, drawn to Fig. 4 and 5.

Species A, Fig. 2, shows that the sensor and the exposed length of the wires are introduced into a covering tube as recited claims 11-14.

Species B, Fig. 3, shows that the covering tube is slipped over an insulated portion of the cable as recited in newly submitted claims 15 and 16.

Species C, Fig. 4 and 5, show that the covering tube comprises at least two layers including at least an outer material and an inner material coupled together as recited in newly submitted claims 15 and 17.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 10 is generic claim.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

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readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Youngblood on 7/16/2003 a provisional election was made with traverse to prosecute the invention of Species B, claims 15 and 16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-14 and 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. This application contains claims 11-14 and 17 drawn to an invention nonelected with traverse herein. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: --A METHOD FOR MANUFACTURING A TEMPERATURE PROBE--.

Claim Objections

6. Claims 10, 15 and 16 are objected to because of the following informalities:

Re. Claim 10: It is confused the whether the limitation of "one end of the cable an exposed length of wire with a sensor" in lines 3-4 is connected only one end of wire of the cable with the sensor or a pair of wires is connected with the sensor. It appears to be a pair of wires is connected with the sensor.

The limitation "the exposed lengths" in line 4 lacks antecedent basis.
Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Boehm et al. (US PAT. 5,749,656).

Boehm et al. teach a method of making a thermal probe assembly comprising steps of: introducing a sensor (16) and exposed lengths of wire into a covering element (44) made of insulating material such as a plastic, which is compatible with the insulating material of a sheath of a cable (18,20) as shown in Fig. 3; covering the sensor and the exposed lengths of wire by overmolding the sensor and the exposed lengths with a plastic material, which is compatible with the insulating material of a sheath of a cable (18,20) as shown in Fig. 3 (col. 2, line 33 to col. 3, line 27).

As per claim 16 the covering element (44) comprising a covering tube is covered the insulated portion of the cable as shown in Fig. 3.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boehm et al.

Boehm et al. teach all of the limitations as set forth above except a process of placing and blocking the covering element in a mold to prevent from moving during the injection molding process. The overmolding covering step disclosed in Boehm et al. is an injection molding process (col. 3, lines 21-27). Even though Boehm et al. does not teach how the insulating plastic material is injected into the covering element, it would

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be obvious at the time the invention was made to a person having ordinary skill in the art to have provided placing the covering element fit into a mold die prior to perform the injecting molding process to prevent from moving or vibrating during the injection process.

Response to Arguments

11. Applicant's arguments with respect to claims 10, 15 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Rejections are based on the newly cited reference.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D Kim whose telephone number is 703-308-8356. The examiner can normally be reached on Tuesday-Friday between 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5648.

pdk
July 16, 2003



PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700